

REMARKS

Pending in the present application were claims 1-25 of which claims 1, 16, and 21 are independent claims. Claims 21-25 were withdrawn from consideration based on a provisional election required under 35 U.S.C. § 121. In the Office Action, claims 1-20 were rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention; claims 1, 4, 12-15 and 16 were rejected under 35 U.S.C. § 102(b) as anticipated by Nakamura et al. (U.S. 6,212,043 B1); claims 1-6, 8 and 11-20 were rejected under 35 U.S.C. § 102(e) as anticipated by Sassine et al. (U.S. 2005/0135013); and claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nakamura in view of Zamanzadeh et al., (U.S. 6,361,740 B1). In reliance on the following remarks and the above amendments, the present application containing claims 1-3, 5-20, and new claims 26-31 is in condition for allowance, and reconsideration and notice to that effect is respectfully requested.

Election/Restriction - 35 U.S.C. § 121

In a phone conversation with the examiner on July 12, 2006, David Fairbairn made a provisional election in response to the examiner's restriction requirement under 35 U.S.C. § 121. The election to prosecute the invention of group I (claims 1-20) is confirmed, and claims 21-25 are canceled without prejudice to the right to file a divisional application at a later time.

Claim Rejections**1. 35 U.S.C. § 112: Claims 1-20**

Claim 1 has been amended and is now in allowable form with respect to section 112, second paragraph, as it particularly points out and distinctly claims the subject matter which Applicants regard as the invention. Claim 1 has been amended to replace the recitation "structural damping material having high stiffness and damping capacity" with "structural damping material having a modulus of elasticity greater than 10 gigapascals." Similarly, dependent claim 2 has been amended to replace the recitation "structural damping material having high stiffness and damping capacity" with the recitation "structural damping material having a modulus of elasticity greater than 10 gigapascals." Dependent claim 4 has been

canceled. Claims 3 and 5-15 depend from claim 1 and are allowable therewith.

Claim 16 has been amended and is now in allowable form with respect to section 112, second paragraph, as it particularly points out and distinctly claims the subject matter which Applicants regard as the invention. Claim 16 has been amended to replace the recitation “a first structural damping material having high stiffness and damping capacity” with the recitation “a first structural damping material having a modulus of elasticity greater than 30 gigapascals.” Dependent claim 19 has been amended to replace the recitation “a second structural damping material having high stiffness and damping capacity” with the recitation “a second structural damping material having a modulus of elasticity greater than 10 gigapascals.” Claims 17 and 18 depend from claim 16 and are allowable therewith. Claim 20 depends from claim 19 and claim 16 and is allowable therewith.

2. 35 U.S.C. § 102(b): Claims 1, 4, 12-15 and 16

For a claim to be anticipated, each and every element as set forth in the claim must be found in a single prior art reference. See M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Nakamura does not anticipate claims 1, 4, 12-15 and 16, as each respective claim recites at least one limitation not found therein.

Independent claims 1 and 16 both recite a head suspension assembly, which includes a hinge component and a gimbal component at least one of which is made from, in whole or in part, a structural damping material. Nakamura does not disclose, teach, or suggest either a hinge or gimbal made from a structural damping material. Nakamura discloses pasting a damping material to an existing head suspension assembly. See, e.g., Nakamura col. 1, lines 66-67 – col. 2, lines 1-3 (“head suspension ... has a construction in which a damping material is mounted over the flat part to the curved part of the supporting arm of a head supporting spring of a disk unit”); Nakamura col. 3, lines 48-50 (“pasting the aforementioned damping material **14** on flat and curved parts of a head supporting spring **2** equipped with magnetic head **1** on its tip as shown in FIG. 2”). Nakamura does not anticipate either of claims 1 or 16, because it fails to disclose, teach or suggest each and every limitation found therein. Claims 12-15 depend from claim 1 and are allowable therewith.

3. 35 U.S.C. § 102(e): Claims 1-6, 8 and 11-20

For a claim to be anticipated, each and every element as set forth in the claim must be found in a single prior art reference. See M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Sassine (U.S. 2005/0135013 A1) does not anticipate claims 1-6, 8 and 11-20, as each respective claim recites at least one limitation not found therein.

Independent claims 1 and 16 both recite a head suspension assembly, which includes a hinge component and a gimbal component at least one of which is made from, in whole or in part, a structural damping material. Sassine does not disclose, teach, or suggest either a hinge or gimbal made from a structural damping material. Sassine discloses attaching a damping layer (and sealing layer over the damping layer) to the suspension assembly as a distinct component, but nowhere does Sassine disclose or teach making the components of the suspension assembly, in whole or in part, from a structural damping material. See, e.g., Sassine ¶ 20 (“[i]n the embodiments illustrated below, a damping layer and a sealing layer are disposed on a surface overlying a flexible region of a suspension component”); Sassine ¶ 58 (“[t]he larger regions of high strain are then covered with complex patterns of damping and sealing layers **412, 414, 418, 420**”). The Office Action stated that Sassine anticipates dependent claim 8 by showing “that the hinge component has no external structural damping material attached thereto,” citing FIG. 15 as showing such a structure. However, FIG. 15 and the accompanying disclosure shows and teaches precisely that which claim 8 excludes; components of a suspension assembly with a damping layer attached thereto (Sassine ¶ 58 (“[t]he larger regions of high strain *are then covered with* complex patterns of damping and sealing layers **412, 414, 418, 420**”) (emphasis added)). In short, Sassine teaches a hinge (or gimbal) with a damping component attached thereto, while Applicants invention includes a hinge (or gimbal) that is the damping component and a damping component that is the hinge (or gimbal). Sassine (U.S. 2005/0135013 A1) does not anticipate claims 1 and 16, as it fails to disclose, teach or suggest each and every limitation found therein. Claims 2-6, 8 and 11-15 depend from claim 1 and are allowable therewith. Claims 17-20 depend from claim 16 and are allowable therewith.

4. 35 U.S.C. § 103(a): Claims 9 and 10

Claims 9 and 10 depend from claim 1. Nakamura does not anticipate claim 1, because the reference fails to disclose each and every element found therein. Therefore, claims 9 and 10 are patentable over Nakamura in view of Zamanzadeh.

CONCLUSION

Claims 1, 2, 16 and 19 have been amended and claim 4 has been canceled to traverse the rejection of claims 1-20 under 35 U.S.C. § 112. Claims 1 and 16 are not anticipated by Nakamura under 35 U.S.C. § 102(b) or Sassine under 35 U.S.C. § 102(e), because neither reference discloses, teaches, or suggests each and every element found in either claim. Claims 2, 3, 5-8 and 11-15 depend from claim 1 and are allowable therewith. Claims 17-20 depend from claim 16 and are allowable therewith. Claims 9 and 10 depend from claim 1 and therefore are patentable over Nakamura in view of Zamanzadeh. In addition, the combinations of features recited in claims 2, 3, 5-15 and 17-20 are independently patentable, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. § 2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988)). Claims 21-25 have been canceled without prejudice to Applicant's right to file a divisional application at a later time. New claims 26-31 have been added. Therefore, all pending claims 1-3, 5-20, and 26-31 are now in condition for allowance and notice to that effect is respectfully requested.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 12/11/06

By: 

David R. Fairbairn, Reg. No. 26,047

THE KINNEY & LANGE BUILDING

312 South Third Street

Minneapolis, MN 55415-1002

Telephone: (612) 339-1863

Fax: (612) 339-6580

DRF/TAG:jsb